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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,073	08/22/2000	Bernd-Georg Pietras	MRKS/0012	5424

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EXAMINER

HAWKINS GAY, JENNIFER M

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/509,073

Applicant(s)

APPLETON ET AL.

Examiner

Jennifer H Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15, 16 and 26-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16 and 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the phrase “can be” in claim 16 makes the claim unclear. The examiner is not sure if the sealing packer is meant to be actuated by hydraulic or pneumatic fluid or not.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15, 16, 26-30, 32, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Delano (US 4,100,968).

*Regarding claims 15 and 16:* Delano teaches a technique for running casing. The apparatus used in that technique includes the following features:

- A body (44, 46, and 48) connected to a top drive (42).
- A set of gripping elements (126 and 128) that are radially displaceable to drivingly engage a tubular so the tubular (34) is threaded into another tubular (30) until adequately tightened.
- A sealing packer (186) that prevents fluid from escaping from the tubular. As seen in Figure 5, fluid traveling up the tubular would press the sides of the packer firmly against the inside wall of the tubular.

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Further regarding claim 16, it should be noted that the applicant has merely claimed that the sealing element can be hydraulically or pneumatically actuated. The examiner has interpreted that to imply that the packer is capable of being actuated in either of those fashions and, since packer 186 is capable of being actuated either hydraulically or pneumatically, packer 186 meets this limitation. Further, it has been held that the recitation that an element is “capable of” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

*Regarding claims 26-28:* The apparatus of Delano includes the following features:

- A body (44, 46, and 48) connected to a top drive (42).
- A set of gripping elements (126 and 128) that is radially displaceable to drivingly engage a tubular so the tubular (34) is threaded into another tubular (30) until adequately tightened. The gripping elements are displaceable by pneumatic fluid (see col. 4, lines 20-25) and are located in a recess in the outer surface of body portion 44 (see Figure 3).

*Regarding claim 29:* The apparatus of Delano includes the following features:

- A top drive (42).
- A body having multiple sections (44, 46, and 48).
- A recess disposed about the outer surface of second section 46.
- A pair radially expandable gripping elements (168 and 170) are located in the recess (see Figure 4).

*Regarding claim 30:* The first section, 44, includes a splined recess (see Figure 3) in which splined connecting members (126 and 128) are located.

*Regarding claim 32:* The gripping elements are radially expanded to engage the inner walls of a tubular (34) (see col. 6, lines 5-20).

*Regarding claim 34:* The body is connected to the top drive (see Figure 1).

*Regarding claim 35:* The top drive rotates the body to provided rotational torque to all a screw connection between multiple tubulars (30 and 34).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delano (US 4,100,968).

Though the gripping elements (168 and 170) shown in Figure 4 of Delano are not radially expandable with pressurized hydraulic or pneumatic fluid, the gripping elements (126 and 128) shown in Figure 3 are (see col. 4, lines 20-25). It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have been obvious to have used hydraulically or pneumatically actuated grippers as taught in column 4, lines 20-25 and Figure 3 for the gripping elements in Figure 4 in order to have used a gripping element that was more accurately controlled.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delano in view of Boyadejeff and Albright et al.

Delano discloses all of the limitations of the above claims except for the casing support being carried by pneumatically operated weight-compensating pistons. Boyadejeff teaches a tubing support system that includes compensating pistons. Albright et al. teaches a weight compensation system that includes pistons that are controlled either hydraulically or pneumatically. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the tubing support system of Boyadejeff in conjunction with the weight compensating pistons of Albright et al. with the pipe connecting device of Delano in order to have been able to use the device with pipes of various lengths, thus weights, without overloading the system (see col. 1, lines 60-65 of Albright et al.).

### ***Response to Arguments***

8. After reviewing applicant's Appeal Brief and the art applied in the previous Office Actions, the examiner determined that, though the art previously used was adequate, Delano (US 4,100,968) was a more appropriate piece of art. The finality of that action is withdrawn.

9. Applicant's arguments filed 6 June 2002 have been fully considered but they are not persuasive. However, the applicant's arguments are moot in view of the new grounds of rejection.

In response to applicant's argument that Gjebedo does not expressly or inherently teach or suggest a sealing element and gripping element in regards to claims 15 and 16, the examiner disagrees. Element 11 in the Gjebedo reference functions as both a sealing and gripping element and claim 15 does not explicitly recite that the sealing element and gripping element must be separate pieces. However, the applicant has made it clear on the record that the two elements are meant to be separate and the rejections using Gjebedo as the primary reference have been withdrawn.

In response to applicant's argument that Gjebedo does not teach "at least on gripping element radially displaceable to drivingly engage a tubular...and a further tubular to be tightened to a required torque", the examiner disagrees. As seen on page 7, lines 1-3, the bellows 15, which are part of the inflatable element 11 are expanded to form a "rigorous friction connection with pipe 3". Page 7 also teaches that pipe 10 is rotated to screw pipe 3 into the top of casing 1. Pipe 10 is attached to the inflatable element 11 thus the inflatable element would be the portion that causes pipe 3 to rotate when pipe 10 is rotated.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at least one recess having a gripping element disposed therein with regards to claims 15 and 16) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Delano does not teach at least on recess having a gripping element disposed therein as recited in claims 26-35, the examiner disagrees. As seen in

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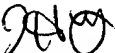
Figure 3 of Delano, slips 126 and 128 are located with a large recess that extends the length of upper section 44; the recess is not labeled.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Friday, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JHG   
June 20, 2002

  
DAVID BAGNELL  
SUPERVISORY PATENT EXAMINER  
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